

### **REMARKS/ARGUMENT**

Claims 1-10, 21-29, and 31-33 are pending in the present application. Claims 1, 10, 22, 25, and 29 have been amended. Claims 11-20 and 30 have been cancelled. Claim 33 has been added. Support for claim 33 can be found, for example, in paragraph [0020] and FIGS. 2 and 5 of pre-grant publication 2004/0142370. No new matter has been added.

Reconsideration of the claims based on the below comments is respectfully requested.

### **Attempted Telephone Interview**

The Applicants attempted a telephone interview with the Examiner for the above-referenced matter. While the Examiner would not grant a telephone interview, the Applicants appreciate the Examiner's time during the coordination efforts.

### **Objection to the Specification**

The specification was objected to as failing to provide proper antecedent basis for the claimed subject matter within claim 10. The Applicant disagrees with this objection because, as discussed in the prior amendment, the specification does provide sufficient support for claim 10. Furthermore, claim 10 is presently amended to broaden the claim to recite that at least two of the overillumination redirection facets are disposed at acute angles from said illumination light guide. Support for this broadening amendment can be found, for example, in paragraph [0018] and FIGS. 2 and 5 of pre-grant publication US 2004/0142370, which illustrate, *inter alia*, overillumination redirection facets disposed at acute angles from the illumination light guide 18.

For at least these reasons, Applicants' request that the objection to the specification be withdrawn. No new matter has been added.

### **Anticipation Rejection of Claims 1-3, 7-9, 21-24 and 29-32 Based on Lemelson**

Claims 1-3, 7-9, 21-24, and 29-32 were rejected under 35 U.S.C. § 102(b) as being anticipated by Lemelson US 4,803,992 ("Lemelson"). Claim 30 has been cancelled, and thus, the rejection of that claim is rendered moot.

Lemelson's system differs from the claimed invention as described below. Lemelson discloses a catheter with an elongated housing 11 with a cable formed of four separate flexible light pipes 22, 24, 26, 28. Column 3, lines 39-50. The apparatus also contains a plurality of reflective surfaces 14 and 15. Column 4, lines 25-26. Light directed along and from the end of light pipe 22 is reflected through fluid, such as body fluid existing in a cavity 16. Column 4, lines 42-46. However, in contrast to the claimed invention, Lemelson fails to disclose one or more overillumination redirection facets disposed at one or more angles relative to an input light path to intersect overilluminating light such that the overilluminating light is directed away from an input light path.

### Independent Claim 1

Amended claim 1 recites a format for optical analysis of samples comprising, *inter alia*, (i) an illumination light guide in optical communication with an illumination input area and forming an input light path; (ii) an overillumination redirection component adjacent to and in optical communication with the illumination input area and the illumination light guide; and (iii) the overillumination redirection component comprising one or more overillumination redirection facets disposed at one or more angles relative to the input light path to intersect overilluminating light such that the overilluminating light is directed away from the input light path.

Lemelson discloses a device 10 that contains a plurality of reflecting surfaces 14 and 15. *See* FIG. 1; column 4, lines 25-26. Lemelson further describes that reflecting surfaces 14 and 15 receive light energy passed through the lens 23 of the light pipe 22 from a source of light located at the other end of light pipe 22. However, unlike claim 1, reflecting surfaces 14 and 15 are not overillumination redirection facets disposed at one or more angles relative to the input light path to intersect overilluminating light such that the overilluminating light is directed away from the input light path. That is, reflecting surfaces 14 and 15 merely redirect light through a fluid and fail to direct overilluminating light away from an input light path. In fact, reflecting surfaces 14 and 15 direct light from light pipe 22 to light pipe 28, not away from the input light path, as recited in amended claim 1. *See* Lemelson, FIG. 1; column 4, lines 25-54. Furthermore, Lemelson fails to teach or suggest an overillumination redirection component located adjacent to and in optical communication with an illumination input area and an illumination light guide. In fact, Lemelson in general fails to teach or suggest an overillumination redirection component or

an overillumination redirection facet. Thus, Lemelson does not, and cannot, teach or suggest amended claim 1.

For at least the reasons cited above, amended claim 1 is neither anticipated by nor rendered obvious over Lemelson, and thus, should be in a condition for allowance.

#### Independent Claim 29

Amended claim 29 recites a format for optical analysis of samples comprising, *inter alia*, (i) an illumination light guide in optical communication with an illumination input area and forming an input light path; and (ii) one or more overillumination facets located adjacent to and in optical communication with the illumination input area and the illumination light guide, the overillumination facets disposed at one or more angles relative to the input light path to direct overilluminating light away from the input light path.

As discussed for claim 1, Lemelson discloses a device 10 that contains a plurality of reflecting surfaces 14 and 15. *See* FIG. 1; column 4, lines 25-26. Lemelson further describes that reflecting surfaces 14 and 15 receive light energy passed through the lens 23 of the light pipe 22 from a source of light located at the other end of light pipe 22. However, unlike claim 29, reflecting surfaces 14 and 15 are not overillumination facets disposed at one or more angles relative to the input light path to direct overilluminating light away from the input light path. Rather, reflecting surfaces 14 and 15 direct light from light pipe 22 to light pipe 28. *See* Lemelson, FIG. 1; column 4, lines 25-54. Furthermore, Lemelson fails to teach or suggest an overillumination facet located adjacent to and in optical communication with an illumination input area and an illumination light guide. Thus, Lemelson does not, and cannot, teach or suggest amended claim 29.

For at least the reasons cited herein, amended claim 29 is neither anticipated by nor rendered obvious over Lemelson, and thus, should be in a condition for allowance.

#### Dependent Claims 2, 3, 7-9, 21-24, 31, and 32

Claims 2, 3, 7, 9, 21-24, 31, and 32, which depend either directly or indirectly from claims 1 or 29, are neither anticipated by nor rendered obvious over Lemelson for at least the reasons discussed above in connection with claims 1 and 29. Thus, claims 2, 3, 7, 9, 21-24, 31, and 32 should also be in a condition for allowance.

**Anticipation Rejection of Claims 1-3, 7, 9, 21-24, and 29-32 Based on Meserol**

Claims 1-3, 7, 9, 21-24, and 29-32 were rejected under 35 U.S.C. § 102(b) as being anticipated by Meserol EP 0 254 246 (“Meserol”). Claim 30 has been cancelled, and thus, the rejection of that claim is rendered moot.

**Independent Claim 1**

Meserol’s system differs from the claimed invention as described below. Meserol discloses a cuvette 10 with a cavity 22. *See FIGS. 1-4; column 4, lines 25-40.* Meserol further discloses a light beam 30 from source 32 which passes through the cuvette and is reflected by reflecting prism 50 across cavity 22 to reflecting prism 48 where the light is reflected to optical element 36. *See FIG. 5; column 5, lines 22-46; column 6, lines 10-41.* Similar to the shortcomings of Lemelson discussed above, Meserol, too, fails to disclose, teach or suggest overillumination redirection facets disposed at one or more angles relative to the input light path to intersect overilluminating light such that the overilluminating light is directed away from the input light path. That is, reflecting prisms 48 and 50 are adapted to merely reflect light through a fluid and fail to direct overilluminating light away from an input light path, as generally recited in claim 1. Similarly, Meresol also fails to teach or suggest an overillumination redirection component located adjacent to and in optical communication with an illumination input area and an illumination light guide. Thus, Meresol does not, and cannot, teach or suggest amended claim 1.

For at least the reasons cited herein, amended claim 1 is neither anticipated by nor rendered obvious over Meresol, and thus, should be in a condition for allowance.

**Independent Claim 29**

As discussed above for claim 1, Meserol’s system differs from the claimed invention. Similar to the shortcomings of Lemelson, Meserol, too, fails to disclose, teach or suggest overillumination facets disposed at one or more angles relative to the input light path to direct overilluminating light away from the input light path. That is, reflecting prisms 48 and 50 are adapted to merely reflect light through a fluid and fail to direct overilluminating light away from an input light path, as recited in claim 29. Similarly, Meresol also fails to teach or suggest an

overillumination facet located adjacent to and in optical communication with an illumination input area and an illumination light guide. Thus, Meresol does not, and cannot, teach or suggest amended claim 29.

For at least the reasons cited herein, amended claim 29 is neither anticipated by nor rendered obvious over Meresol, and thus, should be in a condition for allowance.

**Dependent Claims 2, 3, 7, 9, 21-24, 31, and 32**

Claims 2, 3, 7, 9, 21-24, 31, and 32, which depend either directly or indirectly from claim 1 or 29, are neither anticipated by nor rendered obvious over Meresol for at least the reasons discussed above in connection with claims 1 and 29. Thus, claims 2, 3, 7, 9, 21-24, 31, and 32 should also be in a condition for allowance.

**Obviousness Rejection of Claims 4-6 and 25-28 Based on Lemelson, Meserol, Lundsgaard, Lipson and/or Naka**

Claim 4 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Meserol in view of Lundsgaard US 5,525,518 (“Lundsgaard”). Claim 5 was rejected as being unpatentable over Meserol in view of Naka US 6,001,307 (“Naka”). Claim 6 was rejected as being unpatentable over Lemelson and Meserol. Claims 25 and 26 were rejected as being unpatentable over Lemelson in view of Lipson US 4,710,623 (“Lipson”) and Meserol in view of Lipson. Claim 27 was rejected as being unpatentable over Meserol in view of Lipson and Lundsgaard. Claim 28 was rejected as being unpatentable over Meserol in view of Lipson and Naka.

As discussed above, since all the elements of claim 1 cannot be found in Lemelson or Meserol, a *prima facie* case of anticipation cannot be established for the claimed invention. Furthermore, the rejection of dependent claims 4-6 based on Lemelson, Meserol, Lundsgaard, Naka, or any combination thereof, does not overcome the deficiencies discussed above for the anticipation rejections of independent claim 1. In this regard, Lemelson, Meserol, Lundsgaard, Naka, or any combination thereof, do not disclose or suggest all the elements of claims 4-6.

Furthermore, Lemelson, Meserol, Lundsgaard, Lipson, Naka, or any combination thereof, fail to disclose all the elements of claims 25-28, and thus, a *prima facie* case of obviousness cannot be established for these claims. For example, similar to claim 1, Lemelson and Meresol

fail to disclose, teach or suggest overillumination redirection facets disposed at one or more angles relative to the input light path to intersect overilluminating light such that the overilluminating light is directed away from the input light path – claim 25 recites at least three. Lipson does not overcome the shortcomings of Lemelson or Meresol. Lipson discloses a reflective coating 22 layered over a first end 14 of a cable 12. *See* column 4, lines 26-28. As shown in FIG. 2 and 5, the reflective coating 22 of Lipson is similar to the reflecting surface 14 and 15 in Lemelson and the reflecting prisms 48 and 50 in Meresol. That is, the citations in the Office Action to Lipson does not add anything new to the citations from Lemelson or Meresol. In this regard, Lemelson, Meserol, Lundsgaard, Lipson, Naka, or any combination thereof, do not disclose or suggest all the elements of claims 25-28.

For at least these reasons, claims 4-6 and 25-28 are not rendered obvious over Lemelson, Meserol, Lundsgaard, Lipson, Naka, or any combination thereof. Thus, claims 4-6 and 25-28 should also be in a condition for allowance.

### **CONCLUSION**

Applicants submit that claims 1-10, 21-29, and 31-33 are in condition for allowance and action toward that is respectfully requested. If there are any matters which may be resolved or clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney at (312) 425-8552.

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It is believed that no fees are due other than the RCE fee. However, should any fees be required (except for payment of the issue fee) or credits due, the Commissioner is authorized to deduct the fees from or credit any overpayments to Nixon Peabody LLP Deposit Account No. 50-4181, Order No. 247082-000274USPT.

Respectfully submitted,

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